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Patent

Attorney's Docket No. 033392-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: )  
Eberhard HILDT *et al.* ) Group Art Unit: 1648  
Application No.: 09/830,981 ) Examiner: Myron G. Hill  
Filed: May 3, 2001 ) Confirmation No.: 7240  
For: POLYPEPTIDE MEDIATING CELL )  
PERMEABILITY )

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RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is timely filed in complete response to the Office Action [Requirement for Restriction] mailed July 29, 2003.

Election

Applicants elect Group I (claims 1 and 2, drawn a peptide mediating cell permeability), with traverse, to comply with the requirements of a complete response to the restriction.

Applicants request withdrawal of the restriction or at least modification of the restriction in light of the arguments set forth below.

The instant application is a national phase application of an International PCT Application. Unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. 37 C.F.R. § 1.475. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.*

Applicants submit that the five groups of claims share a common special technical feature. Specifically, all of the claims of the present invention relate to a peptide mediating cell permeability. In fact, Groups I and II are both directed to related biological material. Group I is directed to a peptide mediating cell permeability and Group II is directed to a DNA molecule encoding for the peptide of Group I. Thus, for example, a search of Group I would result in the DNA of Group II encoding the peptide of Group I. If the Examiner does not rejoin all of the claims of the present invention, Applicants respectfully request that the claims of Groups I and II be rejoined.

Further, under M.P.E.P. § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct (M.P.E.P. § 806.05). However, the second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent and distinct inventions. Again, Applicants note that a search of Groups I and II would not be burdensome, as the DNA of

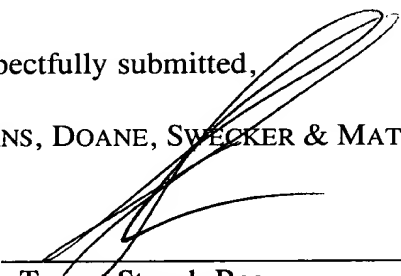
Group II encode the peptides of Group I. The restriction should be withdrawn or, at the very least, reconsidered.

Should the Examiner have any questions or helpful suggestions concerning the subject application, she is respectfully requested to contact Applicants' undersigned representative at (703) 838-6638.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:

  
\_\_\_\_\_  
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**Date: August 28, 2003**



1648

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Eberhard HILDT *et al.*

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AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ A Terminal Disclaimer and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are \_\_\_\_\_.

☒ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$375.00 (2801) ☐ \$750.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted \_\_\_, on \_\_\_, for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least \_\_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADD'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Claim Amendment Fee					
If small entity status is claimed, subtract 50% of Total Claim Amendment Fee					
<b>TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT</b>					

☐ A total fee in the amount of \$ \_\_\_\_\_ is enclosed.

☐ Charge \$ \_\_\_\_\_ to Deposit Account No. 02-4800.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: August 28, 2003

By: \_\_\_\_\_  
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